



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,102	04/13/2004	Jan Batzer	104035.277308	6148

7055 7590 05/27/2008  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

WEBB, WALTER E

ART UNIT

PAPER NUMBER

1612

NOTIFICATION DATE

DELIVERY MODE

05/27/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

pto@gbpatent.com

### Office Action Summary

**Application No.**

10/824,102

**Applicant(s)**

BATZER ET AL.

**Examiner**

WALTER E. WEBB

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 2/25/2008, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Specification***

The objection over the use of trademarks is maintained. Applicant's argued that the inclusion of the "®" is sufficient to indicate that these marks are protected and capitalization is unnecessary. However, MPEP§ 608.01v states that "the examiners are authorized to permit the use of the trademark **if** it is distinguished from common descriptive nouns by capitalization." (emphasis added)

#### ***Claim Rejections - 35 USC § 103 (previous)***

The rejection of claims 1-2 and 5-11 under 35 USC 103(a) as being unpatentable over Harding in view of Schonrock is maintained.

Applicant argues that the formula of Harding encompasses more than a hundred individual compounds and does not mention the specific dioic, 8-Hexadecene-1,16-

dicarboxylic acid. However, 8-Hexadecene-1,16-dicarboxylic acid is a compound of the formula of Harding and as such the artisan would expect it to function in the same manner as the specific examples given in Harding.

Applicant argues that Harding mentions combining its compounds with antioxidants "in passing" and that this is indicative of Harding's failure to provide motivation to the artisan to combine 8-Hexadecene-1,16-dicarboxylic acid with an antioxidant. However, it would have been obvious in a self-evident manner to select an antioxidant from the list of adjuncts, motivated by the unambiguous disclosure of antioxidant, and consistent with the basic principle of patent prosecution that a reference should be considered as expansively as is reasonable in determining the full scope of the contents within its four corners.

Applicant argues that Schonrock also mentions antioxidants as merely one of my optional types of components, which does not convey the "impression that it is critical to use a (any) antioxidant in the composition of SCHONROCK." However, Schonrock teaches a composition that lightens large areas of skin and that antioxidants, such as folic acid, pose an advantage in accordance with their invention. (See col. 12, lines 49-54.) The artisan would be motivated to provide an antioxidant where it poses an advantage in lightening large areas of skin. The prior office action also stated that it would be prima facie obvious to combine two compounds taught to have the same utility to form a new composition for the very same purpose. (See pg. 6)

Applicant also argues that it is not seen why combining Harding with Schonrock "would provide an apparent reason for one of ordinary skill in the art to use an

Art Unit: 1612

antioxidant (and in particular, folic acid, ...) in a composition of Harding which further comprises 8-Hexadecene-1,16-dicarboxylic acid." Again the artisan would be motivated to provide an antioxidant, such as folic acid, where it poses an advantage in lightening large areas of skin, as taught by Schonrock.

In this regard, antioxidants do play a role in lightening of skin, as evidenced by Schonrock.

Applicant argues that the use of antioxidant is not associated with any particular advantage, let alone with an advantage with respect to skin-lightening. Again, the advantage in lightening skin was disclosed in Schonrock.

Applicant argues that the concentration of dioic acid(s) in the composition of Harding (15% and 20%) is significantly higher than the ranges recited in the instant claims and this is evidence of obviousness over Harding. However Harding teaches that the concentration can be as low as 0.1% and as high as 30%. Accordingly, the disclosure of Harding includes a composition where the dioic is 1%. This was addressed in the previous action by stating it would have been obvious to one of ordinary skill in the art to vary and/or optimize the amount of the dioic.

### ***Obvious-type Double Patenting***

Applicant's request that the obvious-type double patenting rejection be held in abeyance until the Examiner has indicated allowable subject matter.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1612

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter E. Webb whose telephone number is (571) 270-3287. The examiner can normally be reached on 8:00am-4:00pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Walter E. Webb  
/Walter E Webb/  
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612